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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/707,655	11/07/2000	Alan R. Hirsch	INS-31061-A	9326

22202 7590 06/01/2004

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EXAMINER

TATE, CHRISTOPHER ROBIN

ART UNIT	PAPER NUMBER
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1654

21

DATE MAILED: 06/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/707,655

Applicant(s)

HIRSCH, ALAN R.

Examiner

Christopher R. Tate

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– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 24-33,35,36,38,41,42 and 44-46 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 24-33,35,36,38,41,42 and 44-46 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

The following is a non-final Office action following the decision by the Board of Appeals.

Claims 24-33, 35, 36, 38, 41, 42, and 44-46 have been examined on the merits.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 27 is rendered vague and indefinite by the phrase "decismel units". It is unclear as to what this phrase means - e.g., this unit of measure does not appear to be recognized in the odorant/aroma art, and there does not appear to be a reasonable definition of what this phrase means with respect to an actual unit of measure. Is this attempting to define a measurement involving smell receptor units and/or olfactory concentration levels and if so, how is it actually measured? It is requested that Applicant particular point to a definition of this phrase within the instant specification, or provide objective evidence as to its meaning - e.g., within the odorant/aroma art.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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Claims 24-30, 35, 36, 38, 41, 42, and 44-46 are rejected under 35 U.S.C. 102(b) as being anticipated by the International Product Alert bulletin entitled "Poan Washable Cold Cream Manufacturer: Kurobara Honpo Category: Beauty Skin Care" (01 June 1994 - PROMT Abstract), or by McMath from Adweek's Marketing Week entitled "The Skin Trade Goes Natural" (27 August 1990 - PROMT Abstract).

An article of manufacture comprising, packaged together: a unit dosage amount of an odorant selected from a mixture of licorice-based and banana-nut odorants, a mixture of licorice-based and cucumber odorants, a mixture of lavender and pumpkin pie odorants, and a mixture of baby powder and chocolate odorants, and instructions for use, is claimed. In addition, claim 25 is drawn to an article of manufacture comprising, packaged together" an (undefined) odorant, instructions for use, and at least one of a device for measuring blood flow to the vagina or means for testing olfactory ability in a female.

Each of the cited references teach skin creams comprising cucumber and licorice extracts therein (see PROMT abstracts). The cited commercial cream products would inherently be contained within a vessel (such as a jar) having a cap, and would also inherently be within the claimed levels - e.g., the products would inherently provide a suprathreshold but not irritant amount of the odorant (i.e., based upon the definition provided on page 5, lines 8-19, of the instant specification, the natural cucumber and licorice extract odors within the cited commercial skin creams would inherently be within a level detectable by a normosmic individual but not at a level so high or intense that it would be perceived as noxious or painful - thus, also within the claimed decismel level, as best understood). Further, please note that the functional effects instantly claimed would be inherent to the reference odorant-containing products, including their

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ability to increase or decrease blood flow to the vagina since, as readily admitted by Applicant, women's response to odors are not homogenous and women respond differently depending on their preferences of sexual activities and behaviors; and further, odorant mixtures including, e.g., licorice-based and cucumber odorants had the effect of increasing blood flow to the vagina in some women and decreasing blood flow to the vagina in other women (see, e.g., page 16, line 23 - page 17, line 27 of the instant specification). In addition, the claimed odorants, *per se*, within the cited articles of manufacture are deemed to read upon a "means of testing olfactory ability" as claimed in claim 25 (e.g., the intrinsic aroma given off by such odorants would provide a means to determine a woman's olfactory ability).

With respect to the claimed instructions, please note that it is legally well established that printed matter (instructions for intended use) of a known composition (such as the commercial skin cream products disclosed by the cited references) does not lend patentable distinction to the composition, *per se*. That is, a prior art product, packaged with printed instructions to show its new use, is not patentable - see, e.g., *In re Haller*, 73 USPQ 403 (CCPA 1947). Further, the odorants within the claimed article of manufacture remain functional absent such instructions and, therefore, no functional relationship exists between the instructions and the odorants that would be given patentable weight - see, e.g., *In re John Ngai and David Lin* (Fed. Cir., 03-1524, 5/13/2004) and *In re Gulack*, 703 F.2d 1381 (Fed. Cir.1983). Accordingly, this claim limitation (i.e., instructions for using the claimed article of manufacturer) has not been given any patentable weight.

Therefore, each of the cited references is deemed to anticipate the instant claims above.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 24-33, 36, 38, 41, 42, and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Drug & Cosmetic Industry publication entitled "Scentual responses" (Jan 1996, from PROMT database).

The cited reference discloses that Dr. Alan Hirsch of the Smell and Taste Treatment and Research Foundation at the University of Chicago reported to the American Psychosomatic Society that various odorants including the combination of lavender and pumpkin pie caused increased penile blow flow (see last paragraph).

It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to provide an article of manufacturer comprising a blow-flow effective amount of an odorant, whereby the odorant is a mixture of lavender and pumpkin pie, based upon the beneficial teachings provided by Dr. Hirsh within the cited reference. The adjustment of particular conventional working conditions (e.g., providing a result-effective amount of such a blood-flow odorant mixture as an article of manufacturer within a conventionally-employed, easy-to-use package/container such as those claimed - e.g., within a vial, a jar, a pouch, a can, a dispenser, a wicking material, a capped vessel having a tip, etc.), is deemed merely a matter of design choice, judicious selection, and routine optimization which is well within the purview of the skilled artisan, based upon the beneficial teachings provided by Dr. Hirsch. Further, please

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note that the functional effects instantly claimed would be intrinsic to the odorants disclosed by Dr. Hirsch, including their ability to increase or decrease blood flow to the vagina since, as readily admitted by Applicant, women's response to odors are not homogenous and women respond differently depending on their preferences of sexual activities and behaviors; and further, odorant mixtures had the effect of increasing blood flow to the vagina in some women and decreasing blood flow to the vagina in other women (see, e.g., page 16, line 23 - page 17, line 27 of the instant specification). Also, as noted above - the claimed odorants, *per se*, are deemed to read upon a "means of testing olfactory ability" as claimed in claim 25 (e.g., the intrinsic aroma given off by such odorants would provide a means to determine a woman's olfactory ability).

Again, with respect to the claimed instructions, please note that it is legally well established that printed matter (instructions for intended use) of a known composition (such as the commercial skin cream products disclosed by the cited references) does not lend patentable distinction to the composition, *per se*. That is, a prior art product, packaged with printed instructions to show its new use, is not patentable - see, e.g., *In re Haller*, 73 USPQ 403 (CCPA 1947). Further, the odorants within the claimed article of manufacture remain functional absent such instructions and, therefore, no functional relationship exists between the instructions and the odorants that would be given patentable weight - see, e.g., *In re John Ngai and David Lin* (Fed. Cir., 03-1524, 5/13/2004) and *In re Gulack*, 703 F.2d 1381 (Fed. Cir. 1983). Accordingly, this claim limitation (i.e., instructions for using the claimed article of manufacturer) has not been given any patentable weight.

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Thus, the invention as a whole is *prima facie* obvious over the reference, especially in the absence of evidence to the contrary.

Claims 24-30, 35, 36, 38, 41, 42, and 44-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over the International Product Alert bulletin entitled "Poan Washable Cold Cream Manufacturer: Kurobara Honpo Category: Beauty Skin Care" (01 June 1994 - PROMT Abstract), and McMath from Adweek's Marketing Week entitled "The Skin Trade Goes Natural" (27 August 1990 - PROMT Abstract).

The references are relied upon for the reasons discussed *supra*.

Based upon the beneficial teachings provided by the cited references with respect to the commercial skin care products disclosed therein, it would have been obvious to one of ordinary skill in the art to provide such articles of manufacturer within one or more conventional, easy-to-use containers/vessels (such as those claimed) commonly employed within the skin care cosmetic art.

Thus, the invention as a whole is *prima facie* obvious over the references, especially in the absence of evidence to the contrary.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

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A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 24-33, 36, 38, 41, 42, and 44 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 22-23 of U.S. Patent No. 5,885,614. An obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but an examined application claims are not patentably distinct from the reference claims because the examined claims are either anticipated by, or would have been obvious over, the reference claims. See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Ed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993), *In re Longi*, 759, F.2d 887, 225 USPQ 645 (Fed. Cir. 1985).

Although the conflicting claims are not identical, they are not patentably distinct from each other because both are drawn to an article of manufacture comprising at least one of the claimed mixture of odorants - e.g., lavender and pumpkin pie odorants; as well as being packaged within the same types of commercial containers/vessels. That is, claims 22 and 23 of US '614 recites an article of manufacture comprising various odorants including various mixtures of odorants such as instantly claimed - e.g., a mixture of lavender and pumpkin pie odorants; packaged in a form such as one or more of the forms instantly claimed - e.g., in the form of a liquid (cologne) or solid within a vessel having a cap, an aerosol spray, a pump-type spray, a nasal spray, a blister pack, a scratch-and-sniff odor patch containing microcapsules (see, e.g., claims 16 and 19 of US '614 from which claims 22 and 23 respectively depend). The US '614

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packaged article of manufacture of claims 22-23 differs from the instantly claimed packaged article of manufacture in that it is drawn to a different intended use (including instructions for such use) than that instantly claimed (i.e., the instantly claimed article of manufacture is intended for altering blood flow to the vagina of a female, whereas the article of manufacture of claims 22-23 of US '614 is intended for increasing penile blood flow in a male). However, as discussed above, the intended use of the instantly claimed article of manufacture does not patentably distinguish the article of manufacture, *per se*, since such undisclosed use is inherent to the article of manufacture of claims 22-23 of US '614. In order to be limiting, the intended use must create a structural difference between the instantly claimed article of manufacture and the article of manufacture of claims 22-23 of US '614. In the instant case, the intended use does not create a structural difference, thus the intended use is not limiting. Please further note that the functional effects instantly claimed would be intrinsic to the odorants (e.g., the mixture of lavender and pumpkin pie odorants) within the claimed article of manufacture recited in claims 22-23 of US '614, including their ability to increase or decrease blood flow to the vagina since, as readily admitted by Applicant, women's response to odors are not homogenous and women respond differently depending on their preferences of sexual activities and behaviors; and further, odorant mixtures had the effect of increasing blood flow to the vagina in some women and decreasing blood flow to the vagina in other women (see, e.g., page 16, line 23 - page 17, line 27 of the instant specification). In addition (as discussed *supra*), with respect to the instantly claimed instructions, please note that it is legally well established that printed matter (instructions for intended use) of a known product does not lend patentable distinction to the product, *per se*. That is, a prior art product, packaged with printed instructions to show its new use, is not

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patentable - see, e.g., *In re Haller*, 73 USPQ 403 (CCPA 1947). Further, the odorants within the instantly claimed article of manufacture remain functional absent such instructions and, therefore, no functional relationship exists between the instructions and the odorants that would be given patentable weight - see, e.g., *In re John Ngai and David Lin* (Fed. Cir., 03-1524, 5/13/2004) and *In re Gulack*, 703 F.2d 1381 (Fed. Cir. 1983). Accordingly, this claim limitation (i.e., instructions for using the claimed article of manufacturer) has not been given any patentable weight with respect to the above obviousness-type double patenting rejection. Also, as noted above - the claimed odorants of US '614, *per se*, are deemed to read upon a "means of testing olfactory ability" as recited in instant claim 25 (e.g., the intrinsic aroma given off by such odorants would provide a means to determine a woman's olfactory ability). The adjustment of particular conventional working conditions (e.g., providing the claimed article of manufacture of US '614 within a particular type of capped vessel such as in a capped vessel having a tip or wick impregnated with the odorants) is deemed merely a matter of judicious selection and routine optimization which is well within the purview of the skilled artisan.

Conclusion

No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher R. Tate whose telephone number is (571) 272-0970. The examiner can normally be reached on Mon-Thur, 6:30-4:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brenda Brumback can be reached on (571) 272-0961. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Christopher R. Tate
Primary Examiner
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